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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,875	11/13/2003	Seong-Jin Moon	1293.1075C	6291

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,875

Applicant(s)

MOON ET AL.

Examiner

Thai Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/339,192.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/04&10/13/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. 101 because claims 1-4 are directed to a recording medium for storing nonfunctional descriptive material.

Data structures non claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, and 10-11 of U.S. Patent No. 6,757,480 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 1 of this application, claims 1, 8, and 10 of U.S. Patent No. 6,757,480 B1 recite a recording medium comprising a first region having data for a plurality of still pictures; and a second region having at least one still picture group information for arranging still picture data in the first region into at least one still picture group, including sizes of still pictures in the one still picture group and start position information of the one still picture group, and for controlling a recording and/or reproducing apparatus to manages still pictures at a group level, wherein the still picture group information includes still picture group general information containing start position information of each still picture group and information indicating a number of video parts in the one still picture group, the information for still pictures containing the position information thereof, and wherein the sizes of the still pictures includes size information of video parts of the still pictures. It is noted that claim 1 of this application is broader than and encompasses claims 1, 8, and 10 of U.S Patent No. 6,757,480 B1 and, therefore, obviousness-type double patenting rejection is applied.

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Regarding claim 2 of this application, claims 1, 8, and 10 of U.S. Patent No. 6,757,480 B1 do not recite the claimed wherein the maximum number of still pictures in a group is 64.

Whether the maximum number of still pictures in a group is 64 is not, unless by doing so produces novel and/or unexpected results, is merely considered as well known design options obvious on one of ordinary skill in the art because the specific maximum number in a group provides no significant functional or patentable differences. On the same token that the maximum number in a group is 45 or 55 or 50 would not have been patentable distinct from claims 1, 8, and 10 of U.S. Patent No. 6,757,480 B1 or claim 2 of this application.

Regarding claim 3, claims 1, 8, and 10-11 of U.S. Patent No. 6,757,480 B1 recite a recording medium comprising a first region having data for a plurality of still pictures; and a second region having at least one still picture group information for arranging still picture data in the first region into at least one still picture group, including sizes of still pictures in the one still picture group and start position information of the one still picture group, and for controlling a recording and/or reproducing apparatus to manages still pictures at a group level, wherein the still picture group information includes still picture group general information containing start position information of each still picture group and information indicating a number of video parts in the one still picture group, the information for still pictures containing the position information thereof, wherein the sizes of the still pictures includes size information of video parts of the still pictures, and wherein the one still picture group information further includes size information of audio

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parts for audio data corresponding to still pictures in the one still picture group, and playback time information thereof. It is noted that claim 3 of this application is broader than and encompasses claims 1, 8, and 10-11 of U.S Patent No. 6,757,480 B1 and, therefore, obviousness-type double patenting rejection is applied.

Regarding claim 4 of this application, claim 11 of U.S. Patent No. 6,757,480 B1 further recites the claimed wherein the position information further comprises playback time information of audio data.

6. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 1 of this application, claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1 recite a method of recording and/or reproducing audio and/or video data on a writeable and/or rewritable recording medium, comprising recording a plurality of still pictures in the a first region of the recording medium and at least one still picture group information in a second region of the recording medium; and arranging the plurality of still pictures in the first region into at least one still picture group, wherein the one still picture group information includes sizes of still pictures in the one still picture group and start position information of the one still picture group, so as to manage still pictures at a group level, wherein the recording of the still pictures includes recording consecutively the audio data added to the corresponding still pictures after the still pictures, and wherein the still picture group information includes still picture group

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general information containing start position information for each still picture group and information relating to a number of video parts in each still picture group, and information for the still pictures in each still picture group, the information for the still pictures containing sizes information of each of the still pictures, size information of audio data corresponding to the still pictures and the playback time information. It is noted that recording medium claim 1 of this application is broader than and encompasses method claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1 and, therefore, obviousness-type double patenting rejection is applied.

Regarding claim 2 of this application, claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1 do not recite the claimed wherein the maximum number of still pictures in a group is 64.

Whether the maximum number of still pictures in a group is 64 is not, unless by doing so produces novel and/or unexpected results, is merely considered as well known design options obvious on one of ordinary skill in the art because the specific maximum number in a group provides no significant functional or patentable differences. On the same token that the maximum number in a group is 45 or 55 or 50 would not have been patentable distinct from claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1 or claim 2 of this application.

Regarding claim 3, claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1 recite a method of recording and/or reproducing audio and/or video data on a writeable and/or rewritable recording medium, comprising recording a plurality of still pictures in the a first region of the recording medium and at least one still picture group information in a

second region of the recording medium; and arranging the plurality of still pictures in the first region into at least one still picture group, wherein the one still picture group information includes sizes of still pictures in the one still picture group and start position information of the one still picture group, so as to manage still pictures at a group level, wherein the recording of the still pictures includes recording consecutively the audio data added to the corresponding still pictures after the still pictures, and wherein the still picture group information includes still picture group general information containing start position information for each still picture group and information relating to a number of video parts in each still picture group, and information for the still pictures in each still picture group, the information for the still pictures containing sizes information of each of the still pictures, size information of audio data corresponding to the still pictures and the playback time information. It is noted that claim 3 of this application is broader than and encompasses method claims 1 and 5-6 of U.S. Patent No. 6,721,493 B1 and, therefore, obviousness-type double patenting rejection is applied.

Regarding claim 4 of this application, claim 6 of U.S. Patent No. 6,721,493 B1 further recites the claimed wherein the position information further comprises playback time information of audio data.

7. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7-9 of U.S. Patent No. 6,674,957 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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Regarding claim 1 of this application, claims 1 and 7-8 of U.S. Patent No.

6,674,957 B1 recite an apparatus for recording and/or reproducing audio and/or video data on a writeable and/or rewritable recording medium, comprising a recording processor to signal-process a plurality of still pictures to be recorded in the a first region of the recording medium and a controller to generate still picture group information for arranging the still pictures in the first region into a number of groups so as to manage the still pictures at a group level and to control the generated still picture group information to be recorded in a second region of the recording medium, with the still picture group information including sizes of still pictures in at least one of the still picture groups and start position information of the one still picture group; wherein the still picture group information includes still picture group general information containing start positions of each still picture group and information relating to a number of video parts in each still picture group, and information for the still pictures in each still picture group, the information for the still pictures containing position information thereof; and wherein the position information for the still pictures includes size information of video parts of the still pictures. It is noted that recording medium claim 1 of this application is broader than and encompasses apparatus claims 1 and 7-8 of U.S. Patent No.

6,674,957 B1 and, therefore, obviousness-type double patenting rejection is applied.

Regarding claim 2 of this application, claims 1 and 7-8 of U.S. Patent No.

6,674,957 B1 do not recite the claimed wherein the maximum number of still pictures in a group is 64.

Whether the maximum number of still pictures in a group is 64 is not, unless by doing so produces novel and/or unexpected results, is merely considered as well known design options obvious on one of ordinary skill in the art because the specific maximum number in a group provides no significant functional or patentable differences. On the same token that the maximum number in a group is 45 or 55 or 50 would not have been patentable distinct from claims 1 and 7-8 of U.S. Patent No. 6,674,957 B1 or claim 2 of this application.

Regarding claim 3, claims 1 and 7-9 of U.S. Patent No. 6,674,957 B1 recite an apparatus for recording and/or reproducing audio and/or video data on a writeable and/or rewritable recording medium, comprising a recording processor to signal-process a plurality of still pictures to be recorded in the a first region of the recording medium and a controller to generate still picture group information for arranging the still pictures in the first region into a number of groups so as to manage the still pictures at a group level and to control the generated still picture group information to be recorded in a second region of the recording medium, with the still picture group information including sizes of still pictures in at least one of the still picture groups and start position information of the one still picture group; wherein the still picture group information includes still picture group general information containing start positions of each still picture group and information relating to a number of video parts in each still picture group, and information for the still pictures in each still picture group, the information for the still pictures containing position information thereof; wherein the position information for the still pictures includes size information of video parts of the still pictures, and

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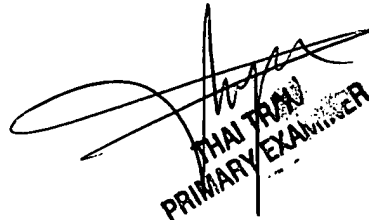
wherein the recording processor consecutively records audio data after ones of the still pictures, and the position information for the still pictures further includes size information of the audio data corresponding to the still pictures, and playback time information thereof. It is noted that recording medium claim 3 of this application is broader than and encompasses apparatus claims 1 and 7-9 of U.S. Patent No. 6,674,957 B1 and, therefore, obviousness-type double patenting rejection is applied.

Regarding claim 4 of this application, claim 9 of U.S. Patent No. 6,674,957 B1 further recites the claimed wherein the position information further comprises playback time information of audio data.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



THAI TRAN
PRIMARY EXAMINER